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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	244/068	3722

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,392

Applicant(s)

KATZ ET AL.

Examiner

James S McClellan

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23,36,39,40,42-50,68-71,75 and 198-207 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23,36,39,40,42-50,68-71,75 and 198-207 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on January 5, 2004, wherein:
claims 21-23, 36, 39, 40, 42-50, 68-71, 75, and 198-207 are pending and
claims 198-207 have been added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21, 22, 36, 39, 40, 42-46, 50, 68-71, 75, 198-204, and 206 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,295,064 (Malec et al.).

Regarding **claim 21**, Malec et al. discloses a method for providing at least one offer of an item, the item including at least one of a good and a service, utilizing an electronic communication device (514) enabling communication between an offeror and a user of the electronic communication device comprising the steps of: establishing communication via the electronic communication device (514) between the offeror and the user to enable the user to at least initiate a primary transaction there between (see column 5, lines 7-22); obtaining primary transaction data related to the primary transaction, the primary transaction data including at least data representing an identity of the user (see column 24, lines 40-56) and data representing a geographic position of the user (see column 1, lines 58-66); utilizing the identity of the user to

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obtain at least a further data element related to the user (see column 24, lines 40-56); utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer from the item in real time (see column 5, line 16, “immediately”) with the primary transaction, and offering the item to the user (see column 24, lines 40-56 and column 1, lines 58-66); **[claim 22]** the electronic communication device is a wireless device (see Figure 4, 504); **[claim 36]** the offer comprises a coupon (see column 24, line 50-52, “coupon”); **[claim 39]** contacting the user via the electronic communications device (514) to offer the at least one item to the user (see column 5, lines 7-22); **[claim 40]** the determination of the at least one offer is subject to negative decision criteria (inherent since the system utilizes user profile and location information, it is inherently negating possible offers); **[claim 42]** the offer is made orally to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 43]** the offer is made visually to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 44]** obtaining primary transaction data includes obtaining a geographic identifier representing the geographic position of the user (see column 1, lines 58-66); **[claim 45]** obtaining data from a carrier associated with the electronic communications device (see column 8, lines 41-65); **[claim 46]** obtaining data from a network associated with the electronic communications device (see column 8, lines 41-65); **[claim 50]** offering at least one item related to an entity that is geographically local to the user (inherent).

Regarding **claim 68**, Malec et al. discloses a method for providing at least one offer as set forth in detail for claim 21. **Claims 69-75** are rejected for reasons similar to claims 22, 36, 39, 40, 42-46 as described above in detail.

Regarding new claims 198-204 and 206, Malec et al. discloses [**claim 198 & 201**] establishing a communication via the electronic communications device includes enabling the user at least to initiate a primary transaction for at least one particular good or service sought by the user (In Malec et al. the user initiates a primary transaction in two way: first, the user travels through the store to an aisle that contains a desirable item and second, the user inserts personal identity and history information into the system via smart card); [**claims 199, 200, 202, & 203**] user provides data to the system (see column 24, lines 40-56); and [**claim 204 and 206**] the data representing the geographic position of the user is communicated electronically from the user to the offeror (see column 6, lines 50-55 and the paragraph bridging columns 8-9; the path of carts through the store is tracked).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view U.S. Patent No. 6,397,057 (Malackowski et al.).

Regarding **claims 23 and 47**, Malec et al. fails to expressly disclose a wireless phone communication device that utilizes ANI for determining a geographic identifier.

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Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing ANI data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with wireless ANI data as taught by Malackowski et al., because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

6. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view of Official Notice.

Regarding **claims 48 and 49**, Malec et al. fails to expressly disclose a user or an operator manually entering geographic identifying information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an operator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

7. Claims 205 and 207 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view of U.S. Patent No. 6,317,718 (Fano).

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Regarding claims 205 and 207, Malec discloses electronically transmitting the geographic position of the user to the offeror as set forth above for claims 204 and 206 but fails to explicitly disclose transmitting the location in real time.

Fano discloses transmitting user position in real time (see column 2, lines 21-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with GPS location tracking as taught by Fano, because GPS location tracking allows the physical presence of a user to be tracked over large areas (such as an outdoor mall), wherein broadening the advertisers ability to track or entice customers into performing a transaction.

Response to Arguments

8. Applicant's arguments filed January 5, 2004 have been fully considered but they are not fully persuasive.

On page 7 (continued on pages 8 and 9), Applicant submits that Malec does not disclose primary transactions that are initiated by users. The Examiner respectfully disagrees. The user initiated a primary transaction in two different ways. First, the user initiates a transaction by physically traversing a specific aisle in a shopping center, whereby placing the shopping cart in close enough proximity to receive offers on the display. Secondly, the user inserts a smart card into the system (see column 24, lines 40-56), wherein the smart card includes personal data and shopping history to allow the retailer to focus specific items that the user intends to purchase. Therefore, the user initiates the purchase transaction by providing specific personal information via a smart card and positions himself/herself in close enough proximity to receive offers.

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On page 9, Applicant argues that Malec fails to disclose transmitting data identifying the shopper. The Examiner disagrees. In column 24, lines 40-56, Malec disclose the use of a smart card to obtain personal identification and demographic information to target advertise to the user. Applicant argues on page 10, that the citation fails to disclose data flow to the system. First, Applicant is arguing limitations not found in the claims. The claims fail to require that user identity information flows to the system. Secondly, the personal identify information and product purchase information is at least inherently submitted to the system for loyalty shopper points (see column 24, line 55).

On page 10, Applicant argues that the new limitations of claims 198-207 are not disclosed by Malec. The features of claims 198-204 and 206 are rejected by Malec et al. as necessitated by Applicant's amendment. New claims 205 and 207 are rejected by Malec et al. in view of Fano. Each of the limitations is supported above by a citation from Malec et al. or Fano.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

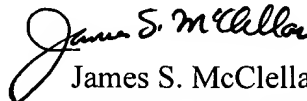
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
March 8, 2004